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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/626,082  | 07/24/2003  | David C. Eby         | 29618/38940         | 9958             |
| 4743  | 7590        | 01/18/2006           | EXAMINER            |                  |
| MARSHALL, GERSTEIN & BORUN LLP<br>233 S. WACKER DRIVE, SUITE 6300<br>SEARS TOWER<br>CHICAGO, IL 60606 |             |                      | GREEN, BRIAN        |                  |
|   |             | ART UNIT             | PAPER NUMBER        | 3611             |

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                   |                         |  |
|------------------------------|-----------------------------------|-------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>            | <b>Applicant(s)</b>     |  |
|                              | 10/626,082                        | EBY ET AL.              |  |
|                              | <b>Examiner</b><br>Brian K. Green | <b>Art Unit</b><br>3611 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 December 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 25 and 27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Allowable Subject Matter***

The indicated allowability of claims 25 and 27 is withdrawn in view of the new interpretation of Strassberg (U.S. Patent No. 5,421,665) and to the newly discovered 112 second paragraph problems appearing in claims 25 and 27. Rejections based on the newly cited reference(s) follow.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second ply which includes first and second tabs as defined in claims 25 and 27 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to include antecedent basis for the phrase “the second ply including integrally formed first and second tabs” as defined in claims 25 and 27.

***Claim Rejections - 35 USC § 112***

Claims 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 25 and 27, lines 7-8, stating that the second ply has first and second tabs is inaccurate since the second ply (38) includes a single tab (54) that is adapted to engage the back surface.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strassberg (U.S. Patent No. 5,421,665) in view of Able (U.S. Patent No. 6,349,491) or Westberg (U.S. Patent No. 4,196,536).

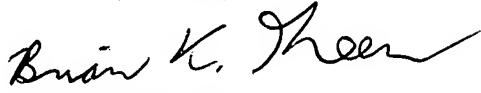
Strassberg shows in figures 1,3, and 6 a "cascadable file jacket" comprising a flexible (based upon the thin layer and the fact that element 18a is made from a thin vinyl)substrate (70) having first and second surfaces and a generally rectangular shape, an expandable file pocket (17,50,51) attached to the flexible substrate, the pocket including first and second plies (see figure 6 where it is clear that the pocket includes first and second plies to form the pocket), the second ply (the back ply which includes portion 57) including integrally formed first and second tabs (the tabs directly above slots 48 and 49 in figure 3) adapted to fixedly engage a back surface of the flexible substrate, and a front surface of the flexible substrate being disposed between the back surface and the first ply, and a plurality of the file pockets are attached to the substrate.

Strassberg discloses the applicant's basic inventive concept except for placing first and second mounting holes in the narrow end of the flexible substrate. Able shows in figure 1 the idea of placing first and second mounting holes in a narrow end of a substrate in order to allow the substrate to be hung. Westberg shows in figure 1 the idea of placing first and second mounting holes in a narrow end of a substrate. In view of the teachings of Able or Westberg it would have been obvious to one in the art to modify Strassberg by placing first and second holes in the flexible substrate since this would allow the device to be hung up in an easier and more convenient manner for both storage and display purposes. In regard to claim 27, Strassberg discloses in column 3, lines 5-9 the idea of forming the pockets by folding the sheet and welding it.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
Jan. 12, 2006